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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,018	10/26/2006	Gregg D. Scheller	54084-62559	9316
21888	7590	01/07/2008		
THOMPSON COBURN, LLP ONE US BANK PLAZA SUITE 3500 ST LOUIS, MO 63101			EXAMINER CHEN, VICTORIA W	
			ART UNIT 3739	PAPER NUMBER
			NOTIFICATION DATE 01/07/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPDOCKET@THOMPSONCOBURN.COM

Office Action Summary

Application No.

10/586,018

Applicant(s)

SCHELLER ET AL.

Examiner

Victoria W. Chen

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,12 and 13 is/are rejected.
- 7) ☒ Claim(s) 2,10,11 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/14/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/1/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 1-3, 7, 8, 10, 12 and 14 are objected to because of the following informalities:

Claim 1, ln. 2, “elgongate” should be changed to --elongate--.

Claim 1, ll. 6-8 recites “a piston mounted on the rod adjacent the rod distal end for axially reciprocating movement of the piston”. The wording of the phrase is unclear because it is written to be interpreted as though the piston causes its own axially reciprocating motion. An alternative phrase, such as --a piston mounted on the rod adjacent the rod distal end wherein the piston is adapted to have axially reciprocating movement toward and away from the rod distal end—or a similar phrase. All instances of this type of phrase should be corrected, for example in claim 2, ll. 12-13, 16-17, 21-22, claim 3, ll. 6-8, 9-10, claim 7, ll. 3-5, claim 8, ll. 2-3 and claim 14, ll. 2-4.

Claim 1, ll. 12-13 recites “a plurality of resilient arms that extend along the rod to distal ends of the arms”. This phrase is unclear because it is obvious that the arms would extend to their own distal ends, and the wording makes it very confusing. This same phrasing occurs in claim 2, ll. 23-25, claim 10, ll. 2-3 and claim 12, ll. 11-12.

Claim 3, ln. 2, “elgongate” should be changed to --elongate--.

Appropriate correction is required.

Specification

The disclosure is objected to because of the following informalities: Element 22 as referenced in the specification as the piston stop is labeled as 20 in the drawings.

Appropriate correction is required.

The abstract of the disclosure is objected to because it is not provided on a separate sheet. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-9, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Richards (US 5634918).

Regarding claim 1, Richards discloses an elongate rod [14'] adapted to be attached to a surgical instrument head [col. 4, ll. 10-12], a piston [34'] mounted on the rod adjacent the rod distal end [Fig. 5], a forward grip member [22'] having a plurality of resilient arms [40'] that extend along the rod to operatively engage the piston [Fig. 5], whereby manual movement of the arm distal ends radially inwardly, moves the piston axially toward the rod distal end [Fig. 6], and movement of the piston axially away from the rod distal end moves the arm distal ends radially outwardly [Fig. 5]. If the first position is interpreted as seen in Fig. 6, and the second position is interpreted as seen in Fig. 5, the second radial spacing between elements 40' is larger than the first radial spacing.

Regarding claim 3, see rejection of claim 1.

Regarding claim 4, Richards discloses a connector [28] at the rod distal end that attaches the rod to a surgical instrument head [col. 4, ll. 10-12].

Regarding claim 5, Richards discloses the rod connector is adapted for removably attaching the surgical instrument heads [col. 8, ll. 56-57].

Regarding claim 6, Richards discloses the connector [28] has a center bore through it, and the piston [34] has proximal and distal ends, the piston distal end extending through the connector center bore [Fig. 4].

Regarding claim 7, since a slot is defined as “a narrow opening for receiving or admitting something”¹, the part of the lumen [labeled 30'] through near the distal end of rod [14] which is adjacent to the connector [28'] as seen in Fig. 5, is interpreted as the slot, while the piston proximal end [labeled at 34'] is positioned in the slot, and the piston distal end [labeled 34F'] is positioned in the connector bore [28'].

Regarding claim 8, element 22' can also be interpreted as a ring.

Regarding claim 9, Richards discloses the ring [22'] has a sliding surface which the resilient arms [40'] engage [22N'], the resilient arms moving between the first radial spacing between the arms and the second radial spacing between the arms in response to the sliding movement of the arms on the ring sliding surface [Figs. 5 and 6].

Regarding claim 12, Richards discloses the plurality of arms [40'] extending from the forward grip member [22'], the movement of the forward grip member relative to the rod [14'] moving the distal ends of the arms relative to the rod [Figs. 5 and 6].

Regarding claim 13, Richards discloses the plurality of arms being circumferentially arranged around the rod and piston [Fig. 5].

¹ slot." *Dictionary.com Unabridged (v 1.1)*. Random House, Inc. 06 Dec. 2007. <Dictionary.com <http://dictionary.reference.com/browse/slot>>.

Allowable Subject Matter

Claim 2 is allowed.

Claims 10-11 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6488695 B1	USPAT Hickingbotham; Dyson W.	Ophthalmologic surgical probe
US 5928263 A	USPAT Hoogeboom; Thomas J.	Surgical instrument with flexible actuator and rigid actuator cover
US 6855126 B2	USPAT Flinchbaugh; David E.	Conformable balloonless catheter
US 5370658 A	USPAT Scheller; Gregg D. et al.	Microsurgical instrument having dexterous handle with interchangeable instrument heads

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victoria W. Chen whose telephone number is (571) 272-3356. The examiner can normally be reached on M-F 8:30-5.

Application/Control Number:
10/586,018
Art Unit: 3739

Page 6

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VWC/
12/6/07

/Michael Peffley/
Primary Examiner
Art Unit 3739